

REMARKS

Claims 14 to 27 are now pending.

Applicants appreciate the Examiner's consideration of the earlier filed Information Disclosure Statement, PTO-1449 form and related references, and respectfully request reconsideration of the present application in view of this response.

With respect to paragraph two (2) of the Office Action, claim 16 was rejected as indefinite under the second paragraph of 35 U.S.C. § 112.

In this regard, claim 16 has been rewritten. It is therefore respectfully submitted that claim 16 complies with the definiteness requirement of the second paragraph of 35 U.S.C. § 112. In particular, claim 16 now recites that "the elastically deformable segments are flexible in three spatial directions". It is respectfully submitted that claim 16 is definite under the second paragraph of 35 U.S.C. § 112. It is therefore respectfully requested that the indefiniteness rejection be withdrawn as to claim 16.

With respect to paragraph four (4) of the Office Action, claims 14 to 27 were rejected under 35 U.S.C. § 103(a) as unpatentable over Oshima et al., U.S. Patent No. 5,444,297 ("the Oshima reference") in view of Asao, U.S. Patent No. 6,325, 642 ("the Asao reference").

As regards the Oshima reference, it concerns a semiconductor power module resistant to electric noises, in which the configuration of wiring patterns for a control circuit arranged on a circuit board decreases the penetration of the electric noises. (See Oshima, Abstract). In this regard, Figure 7 refers to another "example for shielding electromagnetic noises." (See Oshima, Col. 9, lines 46 to 47). In particular, Figure 7 apparently indicates a plurality of partial copper sheets 106a-106c connected to the negative power potentials of certain corresponding areas of the circuit board 131 via conductive wires 107. The partial copper sheets 106a-106c are arranged so as to cover the certain areas thereby providing an effective shielding of electromagnetic noises (See Oshima, Col. 9, lines 46 to 47), conductive pins PI are provided to electrically connect certain circuits of the circuit board 131 with certain circuits of a circuit board 121 on which the various wiring patterns may be provided (See Oshima, Col. 8, lines 46 to 47), and electric power is supplied from an external power source via a power terminal PS(N). (See Oshima, Col. 6, lines 21 to 22).

In short, the system of the Oshima reference merely discusses wiring patterns or shielding to prevent misoperation due to electric noises. The Oshima reference does not

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discuss or address vibrations or mechanical impacts, as contrasted with the benefits that are derived by using the device of claim 14, as is explained further below.

As further regards the primary reference, it is understood that the conductive wires 107 and the conductive pins PI do not provide elastic support for the circuit board 131. It is believed and respectfully submitted that a person having ordinary skill in the art in looking at Figures 6 and 7 would be convinced that the first circuit board 131 is somehow mounted into the housing 101. It is believed that the conductive wires 107 are first straight lined for connecting the ends extending from the board 131 to a cover 102. This indicates that the excess length is used as a connecting toll that is arranged between the cover 102 and the housing 101. Then, the cover 102 is placed in the opening of the housing 101, which is believed to cause the wave form of the conductive wires 107. A like analysis should apply to the conductive pins PI. This explains the length of the conductive wires 107 and of the conductive pins PI. Accordingly, the conductive wires 107 and the conductive pins PI do not provide flexible support for the board 131. Thus, as explained, the Oshima reference does not discuss or address vibrations or mechanical impacts, as contrasted with the benefits that are derived by using the device of claim 14, as is explained further below.

As regards the secondary Asao reference, the reliance on this reference in the Office Action is simply not understood since it only states the following:

[E]ach molded connection article 11 has a plurality of connecting terminals 13 (e.g., four) partially molded in resin blocks 12. The resin blocks 12, which in this example have an elongated rectangular parallelepiped shape, are made of a resin molding material (for example, an epoxy or the like) *having insulating property and heat resistance*. As shown in FIG. 2, faces S3 of the resin blocks 12 abut the parts-mounting face 4a of the printed circuit board 4, and it is preferred that the faces S3 and the parts-mounting face 4a *are not adhered together* by an adhesive or the like. Accordingly, it may be understood that the parts mounting face 4a is supported by the faces S3 of the resin blocks 12, though preferably not adhered.

(See Asao, Col. 3, lines 14 to 26).

The Office Action asserts that the resin blocks 12 are damping elements. It is respectfully submitted, however, that the resin blocks 12 are only referred to as providing

support and as having insulating and heat resistance properties. The Asao reference therefore does not in any way disclose or even suggest use of the resin blocks 12 as damping elements.

In particular, claim 14 concerns an electronic device including a printed circuit board accommodated in a housing part, and a plurality of electrical contact elements electrically connected to a plug-in part of the housing part, in which the printed circuit board is flexibly supported in the housing part by the electrical contact elements, *a plurality of elastically deformable segments are arranged on parts of lengths of the electrical contact elements not inserted into contact openings of the printed circuit board, and a plurality of damping elements via which the printed circuit board is joined at least indirectly to the housing part.*

In this regard, the present application provides, for example, that the contact elements furnished with the elastically deformable segments flexibly support the printed circuit board and the damping elements manufactured separately from the contact elements damp the vibrations. (See Specification, page 2, lines 1 to 16). Hence, “the vibrations and mechanical impacts operating on the housing part are transmitted to the printed circuit board and the components situated thereon only in a very damped fashion.” (Specification, page 2, lines 1 to 3).

In view of the foregoing, it is respectfully submitted that the features of claim 14 discussed above are not in any way disclosed or suggested by Oshima in view of the Asao reference.

It is also respectfully submitted that a person having ordinary skill in the art would not be motivated to modify Oshima in view of the Asao reference. This is because the Oshima and Asao references do not even refer to a flexible suspension or damping mechanical vibrations. Moreover, even if the references provided such a motivation, which they do not, the resulting device would still not include the features of claim 14 discussed above.

As further regard the obviousness rejections, to reject a claim as obvious under 35 U.S.C. § 103, the prior art must disclose or suggest each claim feature and it must also provide a motivation or suggestion for combining the features in the manner contemplated by the claim. (See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990)). Thus, the “problem confronted by the inventor must be considered in determining whether it would have been obvious to combine the references in order to solve the problem”,

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Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 679 (Fed. Cir. 1998), which as referred to above simply do not address the problems met by the subject matter of any of the rejected claims.

The cases of In re Fine, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988), and In re Jones, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992), also make plain that the Office Action's assertions that it would have been obvious to modify the reference relied upon does not properly support a § 103 rejection. It is respectfully suggested that those cases make plain that the Office Action reflects a subjective "obvious to try" standard, and therefore does not reflect the proper evidence to support an obviousness rejection based on the references relied upon. In particular, the Court in the case of In re Fine stated that:

Instead, the Examiner relies on hindsight in reaching his obviousness determination. . . . **One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.**

In re Fine, 5 U.S.P.Q.2d at 1600 (citations omitted; emphasis added). Likewise, the Court in the case of In re Jones stated that:

Before the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. . . .

Conspicuously missing from this record is any evidence, other than the PTO's speculation (if it be called evidence) that one of ordinary skill . . . would have been motivated to make the modifications . . . necessary to arrive at the claimed [invention].

In re Jones, 21 U.S.P.Q.2d at 1943 & 1944 (citations omitted; italics in original).

That is exactly the case here since it is respectfully submitted that the Office Action reflects hindsight, reconstruction and speculation, which these cases have indicated does not constitute evidence that will support a proper obviousness finding.

More recently, the Federal Circuit in the case of In re Kotzab has made plain that even if a claim concerns a "technologically simple concept" -- which is not even the case here,

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there still must be some finding as to the “specific understanding or principle within the knowledge of a skilled artisan” that would motivate a person having no knowledge of the claimed subject matter to “make the combination in the manner claimed”, stating that:

In this case, the Examiner and the Board fell into the hindsight trap. The idea of a single sensor controlling multiple valves, as opposed to multiple sensors controlling multiple valves, is a technologically simple concept. *With this simple concept in mind, the Patent and Trademark Office found prior art statements that in the abstract appeared to suggest the claimed limitation. But, there was no finding as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of Kotzab's invention to make the combination in the manner claimed.* In light of our holding of the absence of a motivation to combine the teachings in Evans, we conclude that the Board did not make out a proper *prima facie* case of obviousness in rejecting [the] claims . . . under 35 U.S.C. Section 103(a) over Evans.

(See *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1318 (Federal Circuit 2000) (italics added)). Here again, there have been no such findings to establish that the features discussed above of the rejected claims are met by the references relied upon. As referred to above, any review of the references, whether taken alone or combined, makes plain that they simply do not describe the features discussed above of the rejected claims.

More recent still, in the case of *In re Lee*, 61 U.S.P.Q.2d 1430, 1433-35 (Fed. Cir. 2002), the Court reversed the Board of Appeals for relying on conclusory statements, stating the following:

*With respect to Lee's application, neither the examiner nor the Board adequately supported the selection and combination of the Nortrup and Thunderchopper references to render obvious that which Lee described. The examiner's conclusory statements that “the demonstration mode is just a programmable feature which can be used in many different device[s] for providing automatic introduction by adding the proper programming software” and that “another motivation would be that the automatic demonstration mode is user friendly and it functions as a tutorial” do not adequately address the issue of motivation to combine. **This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority.** It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to “[use] that which the inventor taught against its teacher.” Thus the Board must not only assure that the requisite findings are made,*

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based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion.

....

In its decision on Lee's patent application, the Board rejected the need for "any specific hint or suggestion in a particular reference" to support the combination of the Nortrup and Thunderchopper references. Omission of a relevant factor required by precedent is both legal error and arbitrary agency action.

[The] "common knowledge and common sense" on which the Board relied in rejecting Lee's application are not the specialized knowledge and expertise contemplated by the Administrative Procedure Act. Conclusory statements such as those here provided do not fulfill the agency's obligation.

[The] Board's findings must extend to all material facts and must be documented on the record, lest the "haze of so-called expertise" acquire insulation from accountability. "Common knowledge and common sense," even if assumed to derive from the agency's expertise, do not substitute for authority when the law requires authority.

Thus, the proper evidence of obviousness must show why there is a suggestion to combine the references so as to provide the subject matter of the claims and its benefits.

Accordingly, it is respectfully submitted that claim 14 is allowable for all of the above reasons. Also, since claims 15 to 27 depend from claim 14, it is respectfully submitted that these claims are allowable for the same reasons that claim 14 is allowable.

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CONCLUSION

In view of the foregoing, it is believed that the objections and rejections have been obviated, and that claims 14 to 27 are allowable. It is therefore respectfully requested that the objections and rejections be withdrawn, and that the present application issue as early as possible.

Respectfully submitted,

KENYON & KENYON

Dated: 12/8/2003

By: Richard L. Mayer

Richard L. Mayer
(Reg. No. 22,490)

One Broadway
New York, New York 10004
(212) 425-7200

CUSTOMER NO. 26646

By [Signature]
Reg. No. 33,865
Aaron C. [Signature]
(212) 425-7200